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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,088	06/15/2001	Robert J. Del Principe	9437.17504	8647
26308	7590	03/08/2004	EXAMINER	
RYAN KROMHOLZ & MANION, S.C.			WONG, STEVEN B	
POST OFFICE BOX 26618			ART UNIT	
MILWAUKEE, WI 53226			PAPER NUMBER	
			3711	
			DATE MAILED: 03/08/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,088

Applicant(s)

DEL PRINCIPE, ROBERT J.

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-31 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 25, 28 and 30 is/are allowed.
6) ☒ Claim(s) 26, 27 and 29 is/are rejected.
7) ☒ Claim(s) 31 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

Claim Rejections – 35 USC 103

1. Claims 26, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pond, III (3,087,728). Regarding claim 26, Pond discloses a simulated golf club comprising a shaft having an annular score line (noted at 28 in Figure 2). Pond states that the shaft (14, 16) is formed from a flexible rubber or a plastic material. Note column 1, lines 35-41 stating that the golf club may be struck against the ground, tree or other element to break the club. It would have been obvious to one of ordinary skill in the art to break the club with one hand on each side of the golf club instead of striking it against the ground or a tree in order to limit possible damage to the club head by impacting a hard surface.

The frangible pin of Pond is capable of bending to some extent before fracturing. Lacking any specificity in the claims as to the extent of the range of the bend angles, the structure of Pond renders the claim obvious.

In the alternative, it would have been obvious to one of ordinary skill in the art to provide a more flexible pin in the golf club of Pond in order to provide a club that does not fracture quite as easily as the frangible pin.

Regarding the limitation for the shaft to be bent to a range of bend angles, during use of the club of Pond the pin would obviously be bent through a range of bend angles before its fracture.

Regarding claim 27, Pond teaches disposing of the broken shaft and replacing it with an additional one.

Regarding claim 29, by stating that the pin is frangible, Pond clearly does not intend for his pin to extend to maximum bend angle over 45 degrees. It would have been obvious to one of ordinary skill in the art to have the club of Pond fracture before reaching 45 degrees in order to provide a more easily breakable club.

Response to Arguments

2. Applicant's arguments filed January 2, 2004 have been fully considered but are not deemed to be persuasive. The applicant contends that the pin of Pond must be sufficiently rigid to break in response to a striking force and therefore, flexing as defined in claim 26 is prohibitive. However, this is not persuasive as even a frangible pin will be capable of flexing to some extent. For example, a dowel rod could be considered to be a frangible pin and would break upon the club's impact with the ground or tree, however, the dowel rod would also be capable of bending to some extent before its fracture. Further, even if there exists a frangible rod that is incapable of any flexion whatsoever, the examiner considers it to be obvious to replace that rod with a more flexible rod in order to prevent unwanted breakage and provide a club that breaks upon more substantial impacts. The applicant appears to be arguing a difference in degree for the amount of flexion of the shaft that is only presented in his remarks and not set forth in the claim language.

Regarding the limitation for the user to hold the shaft between his two hands, this limitation is considered to be obvious given the teachings of Pond. Pond does state that his club is struck against a tree or the ground to fracture the shaft, however, this in no way would preclude one of ordinary skill in the art from fracturing the club with a user's hands. Whether a

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user strikes the club against the ground to fracture it about the score line or the user simply grasps the other end to bend and fracture the club about the score line they are considered to be equivalents in providing a stress on the score line to fracture the club and no patentable distinction is discerned.

Regarding claim 26, by stating that the club is to be struck on the ground to break the shaft, Pond does, in fact, teach flexing the shaft beyond a maximum bend angle to break the shaft along the score line.

Allowable Subject Matter

3. Claims 25, 28, 30 and 31 appear to read over the prior art of record.


Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 703-308-3135. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
March 4, 2004